



23 JAN 2006

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In re Application of	:	
DAMRAU et al.	:	
Application No.: 10/532,523	:	DECISION ON
PCT No.: PCT/EP03/11679	:	
Int. Filing Date: 22 October 2003	:	PETITION UNDER
Priority Date: 25 October 2002	:	
Attorney Docket No.: 09086-00223-US	:	37 CFR 1.47(a)
For: PREPARATION OF PARTIALLY	:	
HYDROGENATED RAC-ANSA-	:	
METALLOCENE COMPLEXES	:	

This is a decision on applicants' petition under 37 CFR 1.47(a) filed on 15 September 2005 in the United States Patent and Trademark Office (USPTO) requesting the acceptance of the application without the signature of joint inventor Stephanie Duchiron.

### **BACKGROUND**

On 15 September 2005, applicants filed a petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, the surcharge under 37 CFR 1.492(e) and a statement of facts by Renate Timmler.

### **DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Items (1) and (3) have been satisfied.

Regarding item (2), Renate Timmler, employee for alleged assignee Basell Polyolefine GmbH, indicates that he obtained Stephanie Duchiron's last known address from co-inventor Patrik Muller. Mr. Timmler sent a combined declaration and power of attorney by mail to Ms. Duchiron's last known address, without response. Mr. Timmler states that he sent the documents

again to the address by courier but the courier was not able to deliver the documents.

Section 409.03(d) states, in pertinent part: where inability to find or reach a nonsigning inventor "*after diligent effort*" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47. Furthermore, the fact that an inventor is hospitalized and/or is not conscious is not an acceptable reason for filing under 37 CFR 1.47. See 37 CFR 1.43 and MPEP 409.02.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

Here, Petitioner has not shown that any further steps were taken to locate the whereabouts of the nonsigning inventor. It is possible that Ms Duchiron was on vacation or away from home or possibly is no longer available at the last known address. Petitioner has not provided sufficient evidence to conclude that Ms. Duchiron refuses or is unavailable to sign the application. Details regarding other diligent efforts to contact Ms Duchiron via mail, telephone and e-mail should be attempted and details of these attempts should be provided by a person with first-hand knowledge. See MPEP Section 409.03(d) regarding the 'diligent efforts' required to conclude that an inventor cannot be reached or located. Thus, item (2) has not been met.

Regarding item (4), counsel states that the declaration of the joint inventors was attached to the petition. However, the declaration(s) executed by joint inventors were not found among the papers submitted via facsimile on 15 September 2005. The declaration must be in compliance with 37 CFR 1.497(a)-(b). Thus, item (4) has not been met at this time.

### CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is DISMISSED, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT,

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Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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